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EXAMINER
FABER, DAVID

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/758,575	SAWADA, KAZUSHIGE
	Examiner	Art Unit	
	David Faber	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>16 November 2006</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>8-17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>8-17</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to the amendment filed on 16 November 2006.

2.   Claims 8-17 have been amended. Claims 1-7, and 18 have been cancelled by

the Applicant.

3.   The objection to Claim 6 has been withdrawn necessitated by the amendment.

The rejection of Claim 2 under 35 USC 112, second paragraph, has been withdrawn

necessitated by the amendment. The rejection of Claims 1-7, and 15-18 under 35 USC

101, has been withdrawn necessitated by the amendment. The rejection of Claims 1-7

under 35 U.S.C. 102(b) as being anticipated by the program Acrobat Reader 5.1

(hereinafter "Acrobat")(Adobe Acrobat Reader 5.1, released 9/17/2002, SS1-15, pp1-

76) has been withdrawn necessitated by the amendment.

4.   Claims 8-17 are pending. Claims 8, 11, and 14 are independent claims.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 11-17 remain rejected under 35 U.S.C. 102(b) as being anticipated by the

program Acrobat Reader 5.1 (hereinafter "Acrobat")(Adobe Acrobat Reader 5.1,

released 9/17/2002, SS1-15, 16-20, pp1-76)

(Added 12/4/2006: Examiner provided additional pages SS16-20 of

screenshots, taken on 12/4/2006, showing the functionality of Adobe Acrobat 5.1

for the rejection of amended Claims 11-17 necessitated by the amendment.)

As per independent claim 11, Acrobat discloses a method comprising:

- Storage means for storing a display area of a given page of the file displayed
  in the file. (pp1, paragraph 1 discloses Acrobat is software used on Microsoft
  Windows and Mac OS. It is inherently known either Windows or Mac OS, both
  programs, are stored on a computer system, wherein the system has memory
  and monitor to view the Acrobat software. Thus, it inherently known when a
  user loads a file to be viewed in Acrobat, the file is loaded or "stored" into
  memory, and is then visually displayed to the user through the monitor
  displayed the pages of the file. SS2 discloses the file displayed after it has
  been "stored" in memory. Furthermore, it is inherent that pressing the print
  screen saves a screenshot which includes storing the display area of a given
  page which was displayed in the window)

- Displaying a given page in the file in the window (SS2)

- Displaying another page in the file in the window so that the same display
  area as that of the given page is displayed on the basis of the display area of
  the stored given page, wherein the display area of said another page is fixed
  to said same display area responsive to a fix button clicked by a user, and
  wherein the page is switched to said another page responsive to a form shift
  button clicked by the user after the user clicks the fix button. (SS 16-20:

Discloses an embodiment of a first page and second page being set or "fixed" to the same display area wherein each of the pages is viewed at one time, and the functionality from displaying only the first page to only showing the second page. SS16 discloses most of a first page, and part of the second page being display in the display area window, but the pages are not fixed to the display area. SS17 discloses of a "fix" button (1701) that enables the display area to only be set or "fix" to only viewing one page at a time. Pressing or clicking on the button, 1701, discloses only one page at a time being shown set to the same display area (shown in 1801 of SS18). SS18 discloses the first page being set or fix to the display area of only that page is being viewed (1801). SS19-20: Discloses changing pages from the first page to the second page, while both pages are set to the same display area when each page, when displayed one at a time, is displayed. Furthermore, Paragraph 043, and 048 discloses that the form shifting function provides the capability to jump from an old page to a new page, or the next page, and have new page display the same display area as was displayed on the old page. Therefore, SS19: Discloses of a "form shift" button that when pressed or clicked on, the fixed display area of viewing one page at a time is switched from the first page (page) to the second page (another page) as the second page is shown in SS20 wherein the second page is shown where the first page was previously shown.)

As per dependent claim 12, Acrobat discloses further comprising area selection means for selecting a certain area within the given page displayed in the window (Using the thumbnail of page 1 shown within the Thumbnail tab window, the user can click the bottom of the page. Doing so changes the display window to refresh and display the bottom of the page. (as shown in SS4-6) In addition, the user can scroll the display area down to a certain area within the page or another page using the down button on the right side of the screen. (e.g. SS2, SS3))

Furthermore, Acrobat discloses shifting means for shifting the certain area selected by the area selection means so that the certain area is substantially at the central region of the window (When the user moves the mouse to a certain area of a page such as shown on SS5, and clicks on that area, that area appears in the central region of the display window after the user clicks on the certain area of the page in the thumbnail window as shown in SS6.

As per dependent claim 13, Claim 13 recites similar limitations as in Claim 11, and 12 combined and is similarly rejected under rationale. Furthermore, Acrobat discloses a method further comprising:

- Receiving a keyword associated with selected the certain area (After selecting the certain area, and loading the find command, the user inputs the words "hand tool" into the find command box. The words "hand tool" is in the selected area thus associated, and the words in the find command box is receiving a keyword. (SS9-12)

- Comparing the keyword with text information contained in the certain area

  corresponding to each page of the file one after another and displaying a

  page of the file containing the text information in the window if the keyword

  and the text information match. (SS12-SS15: The user clicks on the button

  "find" in the find command box with the words "hand tool" Doing so compares

  the word with the text information within the certain area selected and

  throughout the whole document for a match between the two. When a match

  is found, the words are highlighted indicating a find as shown through FIS 13-

  15.

As per independent claim 14, Claim 14 recites similar limitations as in Claim 11,

and is similarly rejected under rationale.

As per independent claim 15, Claim 15 recites similar limitations as in Claim 11,

and is similarly rejected under rationale.

As per dependent claim 16, Claim 16 recites similar limitations as in Claim 12,

and is similarly rejected under rationale.

As per independent claim 17, Claim 17 recites similar limitations as in Claim 13,

and is similarly rejected under rationale.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 8-10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over

Acrobat Reader 5.1 (hereinafter "Acrobat")(Adobe Acrobat Reader 5.1, released

9/17/2002, SS1-15, 16-20, pp1-76).

(Added 12/4/2006: Examiner provided additional pages SS16-20 of

screenshots, taken on 12/4/2006, showing the functionality of Adobe Acrobat 5.1

for the rejection of amended Claims 8-10 necessitated by the amendment.)

As per independent claim 8, Acrobat discloses a device comprising:

- A storage unit for storing a form file (pp1, paragraph 1 discloses Acrobat is

  software used on Microsoft Windows and Mac OS. It is inherently known

  either Windows or Mac OS, both programs, are stored on a computer system,

  wherein the system has memory and monitor to view the Acrobat software.

  Thus, it inherently known when a user loads a file to be viewed in Acrobat, the

  file is loaded or "stored" into memory, and is then visually displayed to the

  user through the monitor displayed the pages of the file. SS2 discloses the file

  displayed after it has been "stored" in memory. Furthermore, Acrobat

  discloses the use of loading, and filling out forms when the PDF documents

  are PDF forms in Acrobat (pp38)

- A display unit for displaying the form file stored in the storage unit in the units

  of a page (pp1, paragraph 1 discloses Acrobat is software used on Microsoft

  Windows and Mac OS. It is inherently known either Windows or Mac OS, both

  programs, are stored on a computer system, wherein the system has memory

and monitor to view the Acrobat software. Thus, a user would be able to use the monitor to view a file such shown in the example of SS2. In addition, this would apply to PDF forms when one is loaded in Acrobat)

- a display determination unit for determining a display area of the form file on the display unit so that the display area is fixed to the same position within the form when the page is switched to another page wherein the display area of said another page is fixed to said same display area responsive to a fix button clicked by a user, and wherein the page is switched to said another page responsive to a form shift button clicked by the user after the user clicks the fix button. (SS 16-20: Discloses an embodiment of a first page and second page being set or "fixed" to the same display area wherein each of the pages is viewed at one time, and the functionality from displaying only the first page to only showing the second page. SS16 discloses most of a first page, and part of the second page being display in the display area window, but the pages are not fixed to the display area. SS17 discloses of a "fix" button (1701) that enables the display area to only be set or "fix" to only viewing one page at a time. Pressing or clicking on the button, 1701, discloses only one page at a time being shown set to the same display area (shown in 1801 of SS18). SS18 discloses the first page being set or fix to the display area of only that page is being viewed (1801). SS19-20: Discloses changing pages from the first page to the second page, while both pages are set to the same display area when each page, when displayed one at a time, is displayed.

Furthermore, Paragraph 043, and 048 discloses that the form shifting function

provides the capability to jump from an old page to a new page, or the next

page, and have new page display the same display area as was displayed on

the old page. Therefore, SS19: Discloses of a "form shift" button that when

pressed or clicked on, the fixed display area of viewing one page at a time is

switched from the first page (page) to the second page (another page) as the

second page is shown in SS20 wherein the second page is shown where the

first page was previously shown. In addition, this would apply to PDF forms

when one is loaded in Acrobat)

However, Acrobat discloses within his Help files wherein a single page generated

conforming to a given regular page corresponds to a single page and a plurality of

pages composes a single file. (SS2-SS4) However, Acrobat fails to specifically disclose

wherein a single form page generated conforming to a given regular form corresponds

to a single page and a plurality of form pages composes a single file. It was well-known

to one of ordinary skill in the art at the time of Applicant's invention that a electronic form

file may contain a plurality of pages. Thus, it would have been obvious to one of

ordinary skill in the art at the time of Applicant's invention to have modified Acrobat's

with the disclosure above since Acrobat would know if the file contain multiple pages or

a single page and have displayed one page at time of a file with multiple pages in the

display window provided the benefit of Acrobat allowing the ability to the user to

manage and fill-in forms, informing the user the number of pages in the file through the

thumbnail window or status bar and able to access the pages without excessive time

delays.

As per dependent claim 9, Acrobat discloses a direction unit for directing the

display determination unit to place an area within the form in the central region in the

central region of the display area. (Acrobat discloses the ability for the display window to

be directed to the next page in sequence using status bar by pressing the next page

button (pp 8) In addition, When the user moves the mouse to a certain area of a page

such as shown on SS5, and the user clicks on a page in the thumbnail window showing

the thumbnails of the pages, the user is send a direction to have that page be viewed in

the display window as that area appears in the central region of the display window after

the user clicks on the certain area of the page in the thumbnail window as shown in

SS6. Thus, it has a direction unit.)

As per dependent claim 10, Acrobat discloses:

- a selection unit for specifying a given area within the form as a selection area,

  and (Using the thumbnail of page 1 shown within the Thumbnail tab window,

  the user can click the bottom of the page. Doing so changes the display

  window to refresh and display the bottom of the page. (as shown in SS4-6)

  The user can choose to view other certain area of the pages. For example,

  the user wants to see the beginning of Page 6 of the file. Thus the user clicks

  on the top part of page 6 thumbnail in the Thumbnail window that results

  viewing the certain area of page in the display window the user selected.

(SS7). Thus, Acrobat has a selection unit for specifying a area to view in the display window.)

- A searching unit for searching text information within the selection area specified by the selection unit over a plurality of form pages in the form file. (Acrobat discloses the ability to search for text within the selected area specified by the user, and throughout the whole document. Pg 20 discloses the method to access the find command where the user can search for text. SS9-15 show the find command being used.)

Response to Arguments

9.   Applicant's arguments filed 16 November 2006 have been fully considered but they are not persuasive.

10.   On pages 7-8, in reference to Claims 8, 11, 14, and 15, Applicant argues that the Adobe reference fails to teach or suggest the use of a fix button or a form shift button. However, the Examiner disagrees.

The Examiner provides additional screenshots, SS16-20, to disclose the functionalities of a "fix" button and "form shift" that Adobe Acrobat discloses. SS 16-20 discloses an embodiment of a first page and second page being set or "fixed" to the same display area wherein each of the pages is viewed at one time, and the functionality from displaying only the first page to only showing the second page. SS16 discloses most of a first page, and part of the second page being display in the display area window, but the pages are not fixed to the display area. SS17 discloses of a "fix"

button (1701) that enables the display area to only be set or "fix" to only viewing one page at a time. Pressing or clicking on the button, 1701, discloses only one page at a time being shown set to the same display area (shown in 1801 of SS18). SS18 discloses the first page being set or fix to the display area of only that page is being viewed (1801). SS19-20 discloses changing pages from the first page to the second page, while both pages are set to the same display area when each page, when displayed one at a time, is displayed. Furthermore, Paragraph 043, and 048 discloses that the form shifting function provides the capability to jump from an old page to a new page, or the next page, and have new page display the same display area as was displayed on the old page. Therefore, SS19 discloses of a "form shift" button that when pressed or clicked on, the fixed display area of viewing one page at a time is switched from the first page (page) to the second page (another page) as the second page is shown in SS20 wherein the second page is shown where the first page was previously shown. In addition, this would apply to PDF forms when one is loaded in Acrobat.)

Conclusion

11.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David Faber whose telephone number is 571-272-2751.

The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 866-217-9197 (toll-free).

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